

REMARKS

In the Office Action mailed September 11, 2006 from the United States Patent and Trademark Office, the Examiner objected to the drawings and to the specification. The examiner rejected claims 3, 5, and 10 under 35 U.S.C § 112, second paragraph, as containing subject matter lacking antecedent basis, rejected claims 1-3 and 8-12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,086,688 to Woodruff (hereinafter “Woodruff”), rejected claims 4-5 under 35 U.S.C. § 103(a) as being unpatentable over Woodruff in view of U.S. Patent No. 4,854,460 to Josephs (hereinafter “Josephs”), and rejected claims 6-7 under 35 U.S.C. § 103(a) as being unpatentable over Woodruff in view of U.S. Patent No. 3,255,554 to Spaeth et al. (hereinafter “Spaeth”). Accordingly, Applicant respectfully provides the following:

The specification and claims 1, 9, and 12 are amended. Claims 2-8 and 11 are canceled.

Please replace the first and fourth sheets of Figures (containing Figures 1, 6, and 7) with the attached replacement sheets.

Objections to the Drawings:

In the Office Action, the Examiner objected to the drawings as failing to comply with 37 C.F.R. 1.84(p)(4). Applicant has amended the specification to modify the terminology used so that the reference characters used in the specification and drawings are consistent. Applicant therefore respectfully submits that the drawings now comply with 37 C.F.R. 1.84(p)(4) and requests removal of the objections to the drawings.

The Examiner also requested that Figure 1 be designated by a legend containing “Prior Art.” Applicant has submitted herewith a replacement sheet containing Figure 1 so designating the Figure.

The Examiner further objected to the drawings under 37 C.F.R. 1.83(a) as failing to show every feature of the invention specified in the claims. Specifically, the Examiner objected to the claim language “locking tongues,” “keepers,” and “an internal door release mechanism” as not being illustrated in the drawings. Applicant has amended the specification, claims, and drawings to comply with the Examiner’s requirement. No new matter has been provided in the amendment. Specifically, Applicant has submitted herewith a replacement sheet containing Figure 6 having new reference numeral 133, and has amended the specification at the paragraph beginning on page 7 line 14 with the following language: “The ends of the bar 132 may be in the form of tongues 133 (see Figure 6) that are held in keepers 134 on the frame 101 when the primary door 124 is closed and latched.” This language clearly shows the use of “tongues” and “keepers” (Applicant notes that keepers were already illustrated in the Figures in the application as submitted.).

Additionally, Applicant has amended the paragraphs beginning on page 8 line 1 and on page 8 line 14 as follows, in relevant part:

It can also be seen from Figures 3 and 4 that the latch mechanism 130 has a part which extends through the thickness of the door to an unlatching member 140 (or “release knob 140”) on the inside surface of the primary door 124 to provide an internal door release mechanism. This internal door release mechanism is shown in more detail in Figure 5 . . .

The internal door release mechanism includes the release knob 140 is-mounted at the top of a stem 146 which projects through a recess in the door and has an opposite end which abuts against the main door-unlatching handle 142. The shaft stem 146 projects through a saucer recess 148 on the inside of the door, and when the release knob 140 is pushed fully home to the floor of the recess 148, the pressure of the stem 146 acting on the unlatching handle 142 will rotate the unlatching handle 142 far enough to release the upper and lower ends of the bar 132 from their keepers 134, so that the door can be opened from inside.

This language shows the use of “internal door release mechanism” as was illustrated clearly in the specification as filed. Applicant therefore respectfully requests withdrawal of the objections.

Objection to the Specification:

In the Office Action, the Examiner objected to the specification for the same reasons discussed above in reference to the objections to the drawings as failing to comply with 37 C.F.R. 1.84(p)(4). Applicant has reviewed the specification, and amended the specification as contained herein to comply with 35 U.S.C. § 112, first paragraph, as requested by the Examiner. Applicant believes that all requirements have been met.

Rejections under 35 U.S.C. § 112, Second Paragraph:

In the Office Action, the Examiner rejected claims 3, 5, and 10 as containing language lacking antecedent basis. Applicant has canceled claims 3 and 5 and has amended claim 10 to correct the antecedent basis issue identified by the Examiner. Applicant therefore respectfully requests removal of the rejections.

Rejections under 35 U.S.C. § 102(b):

In the Office Action, the Examiner rejected claims 1-3 and 8-12 under 35 U.S.C. § 102(b) as being anticipated by Woodruff. M.P.E.P. 2131 sets forth the standard for a rejection of a claim as anticipated under 35 U.S.C. § 102. “To anticipate a claim, the reference must teach every element of the claim.” M.P.E.P. 2131 states further,

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). . . . “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant(s) respectfully submit(s) that the reference(s) cited by the Examiner fail(s) to teach every element of the claim set as provided herein for the following reasons.

Claim 1, as amended, requires: “A rectangular, refrigerated freight container having length width and height dimensions of a standard size, a roof, a floor, walls, a door frame and two doors at one end, the doors being of the same height but with substantially different width dimensions and extending to the floor of the container, the smaller door having locks which can only be operated from inside the container, wherein the larger door has an internal door release mechanism which acts from inside the container on an external door release mechanism, and wherein a security bar can be locked between the two doors to prevent operation of the external door release mechanism, and wherein a part of the door frame itself forms the bottom of the container such that the frame will be in contact with the ground when the container is set down.”

Woodruff fails to teach every element of claim 1, as amended.

Specifically, Woodruff fails to teach a refrigerated container having doors with substantially different width dimensions. Woodruff teaches a container that is to be used for shipping “automobile parts,” “automobile glass” and the like in order to provide secure handling of such goods without shifting and damage during transit. (Col 1 lines 7-18; Col 4 lines 31-50) Woodruff never discloses shipping any items that would require refrigeration of any kind. Additionally, the doors of Woodruff are not substantially different in width; the doors illustrated in Woodruff only differ in width by about 10%.

Woodruff also fails to teach those elements previously contained in claims 4, 6, and 7 that have now been incorporated into amended claim 1. Applicant will address those features in further detail below. Woodruff further fails to teach “wherein a part of the door frame itself forms the bottom of the container such that the frame will be in contact with the ground when the container is set down.” Instead, Woodruff teaches depending supporting legs 8 that support the

container when it is set down. (Fig 1, Col 2 lines 3-5) For at least these reasons, Applicant respectfully submits that claim 1 is not anticipated by Woodruff.

Applicant's invention as claimed in claim 1 is directed to a refrigerated container for a specific application, namely to be used as a temporary refrigerated storage facility, such as at supermarkets where storage capacity may be limited, particularly at certain times of the year. The claimed container has a standard shipping container configuration so that it can be moved using standard handling and transporting equipment; however, it is designed so the main access door (the large door) can be easily opened one-handed, and the door is large enough so that a trolley or pallet handling unit can be moved in and out of the container to move goods out of the container as they are needed. In this way, access at regular intervals may be provided so that the container may be emptied of its contents over time instead of in one operation as is common with most containers while maintaining refrigerated storage of the goods. Therefore, it is important that the container sit on the ground (in contrast to Woodruff) for easy access by a trolley, etc. for unloading goods.

As claim 1 now contains some limitations previously contained in dependent claims 6 and 7, Applicant will address why claim 1 is not unpatentable over the combination of art recited by the Examiner against now-canceled dependent claims 6 and 7. The standard for a Section 103 rejection is set forth in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added). Applicant respectfully submits that the references cited by the Examiner, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. Applicant also respectfully submits that there is no suggestion or motivation to combine the references in the manner suggested by the Examiner

In the Office Action, the Examiner acknowledged that Woodruff does not teach an internal door release mechanism. The Examiner then proposed a combination of Woodruff and Spaeth, indicating that Spaeth teaches an internal door release mechanism, citing column 3 lines 25-30 of Spaeth. Applicant respectfully disagrees with the position taken by the Examiner. Importantly, reference must be made to the full language claimed by Applicant in claim 1. That language provides: “an internal door release mechanism which acts from inside the container on an external door release mechanism.” Applicant respectfully submits that this limitation is not taught or suggested by the combination of Spaeth and Woodruff.

Specifically, the language cited by the Examiner, column 3 lines 25-30, merely discusses details of a latch that prevents “unauthorized operation of the operating shafts from the outside of the car.” (Col 3 lines 14-25) Opening the door of Spaeth from the inside is actually discussed in column 3 lines 50-67. This requires lifting the latch previously discussed, inserting a wrench in a hole, pressing down on the end of the wrench to lift a sleeve, then turning the wrench on the lock shaft. However, Spaeth specifically discloses that the lifting of the sleeve by the wrench disengages Spaeth’s external door release mechanism (the handles 45 in Figure 1). (Col 2 line 67-Col 3 line 8) Spaeth discloses that using the wrench to turn the shaft is done “without causing levers 45 to move outwardly from the surface of the door, thus not disturbing the door seal.” (Col 3 lines 3-5) Therefore, the provided combination of references fails to teach Applicant’s claimed limitation of “an internal door release mechanism which acts from inside the container

on an external door release mechanism,” as Spaeth specifically discloses that the wrench disengages the lock from the external door release mechanism.

Applicant also submits that there is no motivation found in the cited art to combine references in the manner suggested by the Examiner.

Applicant respectfully submits that there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify or combine what the reference teaches. Woodruff and Spaeth fail to suggest the combination of the prior art references cited by the Examiner. “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.” *In re John R. Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Any such suggestion must be “found in the prior art, and not based on applicant’s disclosure.” *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Indeed, “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990). A “clear and particular” showing of the suggestion to combine is required to support an obviousness rejection under Section 103. MPEP § 2142.

In essence, Applicant urges that the combination of the listed references is not a product of a suggestion contained within them, but is a product of inappropriate hindsight analysis. This may be seen in that the Examiner combined references without citing to any portion of either Woodruff or Spaeth as providing motivation for the proposed combination. “Hindsight reconstruction” cannot be used “to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *Ecolochem, Inc. v. S. California Edison Co.*, 227 F.3d 1361,

1371 (Fed. Cir. 2000) (quoting *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)). Rather, “the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references.” *Id.* “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.” *Id.* (quoting *In re Dembicza*k, 175 F.3d 994 (Fed. Cir. 1999)).

Section 103 specifically requires assessment of the invention “as a whole.” The Federal Circuit explained that inventions typically are new combinations of existing principles or features. *Envil. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that “virtually all [inventions] are combinations of old elements”). The “as a whole” instruction in title 35 prevents evaluation of the invention part by part. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004). The Federal Circuit further explained that

[w]ithout this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. [*Ruiz* at 1275.] This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result - often the essence of invention. *Id.*

Contrary to this reasoning, section 103 requires assessment of the invention as a whole. *Id.* This “as a whole” assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner. *Id.* In other words, section 103 requires some suggestion or motivation, before the invention itself, to make the new combination. See *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

Princeton Biochemicals Inc. v. Beckman Coulter Inc., 411 F.3d 1332, 1337 (Fed. Cir. 2005).

In the fifty years following the Spaeth patent, not a single person disclosed the freight container that applicants claim with “an internal door release mechanism which acts from inside the container on an external door release mechanism.” If combining Spaeth’s wrench-operated internal door opener with Woodruff’s container would have really been obvious, wouldn’t at least one person have actually combined the teachings of these two patents during the past half century? Such a rejection completely ignores and makes null and void the “as a whole” assessment that United States patent laws require. If it is not importing hindsight into the obviousness determination to combine two references that those skilled in the art failed to do after fifty years, then this principle must no longer exist in patent law.

Thus, because the Examiner’s hindsight-driven obviousness rejection in light of Woodruff and Spaeth violates and ignores the “as a whole” assessment required under current United States patent law, Applicants respectfully submits that claim 1 is not obvious in light of Woodruff in view of Spaeth. In light of the absence of any suggestion or motivation to combine the above-referenced prior art, the mere fact that such prior art could be combined in a manner suggested by the Examiner does not render the presently-claimed invention obvious. Thus Applicant(s) respectfully submits that for at least the reasons provided herein, the claims set as provided herein overcomes all rejections made by the Examiner in the Office Action.

Rejections under 35 U.S.C. § 103(a):

In the Office Action, the Examiner rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Woodruff in view of Josephs, and rejected claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Woodruff in view of Spaeth. Claims 4-7 have been

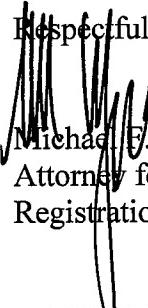
canceled in this amendment and the rejections of the features of those claims now incorporated into claim 1 have been discussed above. The rejections of claims 4-7 are now moot.

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 12 day of February, 2007.

Respectfully submitted,


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